

IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Alexander STRAUB

Application No.: 10/518,454

I. A. Filing Date: June 20, 2003

Filed: August 1, 2005

For: ...METHOD FOR PRODUCING HETEROCYCLIC FLUOROALKENYL SULFONES

Customer Service Window, Mail Stop Amendment

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, 401 Dulany Street
Alexandria, Virginia 22314

Art Unit: 1626

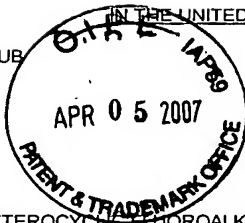
Examiner: Joseph R. Kosack

Washington, D.C.

Atty.'s Docket: STRAUB=1

Confirmation No.: 7860

Date: April 5, 2007



Sir:

Transmitted herewith is a REPLY: REQUEST FOR RECONSIDERATION in the above-identified application.

☐ Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.

☐ No additional fee is required.

☒ The fee has been calculated as shown below:

(Col. 1)		(Col. 2)		(Col. 3)	SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS	RATE	ADDITIONAL FEE		RATE	ADDITIONAL FEE
TOTAL	*	MINUS	** 20	0	x 25	\$		x 50	\$
INDEP.	*	MINUS	*** 3	0	x 100	\$		x 200	\$
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+ 180	\$		+ 360	\$
					ADDITIONAL FEE TOTAL			TOTAL	

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

☒ Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

☒ It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

☐ First - \$ 60.00
☐ Second - \$ 225.00
☐ Third - \$ 510.00
☐ Fourth - \$ 795.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

☐ First - \$ 120.00
☐ Second - \$ 450.00
☒ Third - \$ 1020.00
☐ Fourth - \$ 1590.00

Month After Time Period Set

☐ Less fees (\$ _____) already paid for ____ month(s) extension of time on _____.

☐ Please charge my Deposit Account No. 02-4035 in the amount of \$ _____.

☒ Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$1020.00

☐ A check in the amount of \$ _____ is attached (check no.).

☒ The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK, P.L.L.C.

Attorneys for Applicant(s)

By:

Sheridan Neimark
Registration No. 20,520

Facsimile: (202) 737-3528
Telephone: (202) 628-5197



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Confirmation No.: 7860
Alexander STRAUB)	Art Unit: 1626
I.A. Filing Date: 06/20/2003)	Examiner: Joseph R. Kosack
371(c) Date: August 1, 2005)	April 5, 2007
U.S. Appln. No.: 10/518,454)	ATTY.'S DOCKET: STRAUB=1
For: METHOD FOR PRODUCING)	
HETEROCYCLIC FLUOROALKENYL))	
SULFONES)	

REPLY: REQUEST FOR RECONSIDERATION

Customer Service Window, Mail Stop Amendment
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

04/09/2007 HMARZII 00000058 10518454
01 FC:1253

1020.00 0P

Sir:

Applicant is in receipt of the Office Action mailed October 5, 2006. Attached is a petition for three months' extension of time and payment of the three months' late fee.

The present application has been assigned to a new entity, and the firm of Browdy & Neimark, PLLC, customer number 001444, has been assigned as U.S. attorneys in charge of this application. We request the PTO to change the attorney docket to that indicated above, namely "STRAUB=1", and mail all correspondence to Browdy & Neimark, (624 Ninth Street, N.W. Washington, D.C. 20001-5303).

The Office Action of October 5, 2006, and the prior art relied upon therein have been carefully reviewed. The claims

in the application remain as claims 11-20, and applicant respectfully submits that these claims define patentable subject matter warranting their allowance. Applicant accordingly respectfully requests favorable reconsideration and allowance.

Acknowledgement by the PTO of the receipt of applicant's papers filed under Section 119 is noted.

As regards the restriction requirement, applicant affirms the oral election of Group I, claims 11-20, with traverse. Applicant respectfully does not accept that the PTO may properly examine claims "in part", and does not accept the objection to the claims set forth at the top of page 5 of the Office Action, and accordingly that objection is respectfully traversed.

In this regard, and especially with regard to whatever "part" of claims 11-18 which is deemed "withdrawn from further consideration", applicant maintains the right to claim his invention as broadly as the prior art permits, so long as all statutory requirements are met including those of 35 USC 112. By refusing to consider/examine applicant's claims as broadly as they are drafted, the PTO is in effect rejecting such claims, but without any statutory authority to do so, and without any basis.

Applicant's position is supported by a line of cases going back to the 1970's including *In re Weber et al*, 198 USPQ 328, 331 (CCPA 1978). In *Weber*, the examiner had held the

generic Markush claims to be "improper", constituting a "misjoinder under 35 USC 121." The Board affirmed. The Court reversed, stating in part as follows:

An applicant is given, by the statute, the right to claim his invention with the limitations he regards as necessary to circumscribe that invention, with the provision that the application comply with the requirements of §112. We have decided in the past that §112, second paragraph,... allows the inventor to claim the invention as he contemplates it. [citation omitted]

As a general proposition, an applicant has the right to have **each** claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claim examined in the form he considers to best define his invention. **If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits.** The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the sub genera would be defined by the examiner rather than the applicant, it is not inconceivable that a number of the fragments would not be described in the specification. [italics in original; highlighting added]

The PTO in the present application seeks to do what the *Weber* Court has held is improper.

In a concurring opinion, Judge Rich added the following (198 USPQ at 333):

The practice here challenged is tantamount to a refusal by the PTO **to examine** a single Markush claim in a single application because, in its opinion, it is **broad** enough to

"embrace" or "cover" a plurality of inventions which , if presented separately, would be separately patentable, *assuming* any one of them to be prior art [footnote omitted; italics by Judge Rich]....

The fault in the PTO position is that it overlooks the obvious fact that almost any reasonably broad claim "embraces" or "covers" a multiplicity of inventions, in the sense of "dominating" them, which inventions might be separately patentable if and when presented in separate applications. Logically, this is not a sufficient excuse for refusing to examine a claim on its merits for compliance with 35 USC 101, 102, 103, and 112. None of those statutory sections, of course, justifies a refusal to examine.

The only justification or statutory authority put forward for refusing to examine is 35 USC 121. There is nothing therein, however, to excuse a refusal to examine an elected invention or an applicant's generic (broad) claim reading thereon, notwithstanding the generic claim reads on non-elected inventions and possibly many others, all potentially separately patentable.

The present applicant has presented generic claims and he is entitled to have those generic claims fully examined. If those generic claims meet the requirements of §§101, 102, 103 and 112, the generic claims should be allowed in full.

As regards the Information Disclosure Statement and the commentary near the bottom of page 4 of the Office Action, undersigned advises that at present undersigned has **none** of the references cited in the IDS, and accordingly respectfully requests the PTO to provide copies of same. In the meantime, undersigned will endeavor to obtain copies of the two (2) missing

citations which are understood to be an article in the name of Trost et al and an article in the name of Kenny et al. These will be provided as soon as copies can be procured.

Claims 11-20 have been rejected as obvious under §103 from Watanabe et al WO 01/02378 (Watanabe) in view of Patani et al, "Bioisosterism; a rational approach in drug design" (Patani). This rejection is respectfully traversed.

Watanabe mentions potassium peroxymonosulfate among a large group of oxidizing agents which *"...can be agents used for this purpose in organic chemistry.."*, and further teaches that the preferred oxidizing agents for the fluorinated butenyl compounds disclosed therein are benzoic acid and succinimide derivatives. Watanabe does not suggest the use of a particular oxidizing agent to overcome undesirable side reaction of oxidizing the butenyl double bond. In this sense the oxidizing agent of the present invention provides an unexpected effect which provides an improved yield. Patani's teaching does not provide any teaching which would bring a skilled person in the art to the unexpected effect of the present invention. In other words, there is no reasonable expectation of applicant's success from a consideration of the references.

The teaching of Patani regarding the hydrogen-fluorine substitution in the molecular structure contributes nothing the knowledge in the field with respect to the selectivity of the oxidation reaction and the prevention of the side reaction where

the butenyl double bond is oxidized. Hence, it is maintained that the present invention which provides an unexpected solution to the problem of the undesirable oxidation of the butenyl double bond during the oxidation reaction of the sulfur in the compounds (I) and (II) defines non-obvious subject matter over Watanabe in view of Patani.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 11-20 have also been rejected on the basis of obviousness-type double patenting over claim 6 of the Watanabe U.S. patent 6,734,198 in view of Patani. This rejection is also respectfully traversed.

This rejection, just like the prior art rejection, depends on the purported obviousness of extrapolating the bioisosteric replacement of hydrogen for fluorine of Patani to a very different environment as pointed out above. Applicant respectfully maintains that Patani's teaching contributes nothing to the knowledge in the present field with respect to the selectivity of the oxidation reaction and the prevention of the side reaction where the butenyl double bond is oxidized, and therefore applicant's claims would not have been obvious from a consideration of claim 6 of the '198 patent in view of Patani.

Withdrawal of the rejection is in order and is respectfully requested.

The prior art documents of record and not relied upon by the PTO have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently material to warrant their application against any of applicant's claims.

Applicant believes that all issues raised in the Official Action have been addressed above in a manner that should lead to patentability of the present application. Favorable consideration and early formal allowance are respectfully requested.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By

A handwritten signature in black ink, appearing to read 'S. Neimark', written over a horizontal line.

Sheridan Neimark
Registration No. 20,520

SN:kg
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
G:\BN\M\MAKH\straubl\pto\2007-04-05 PCTRPLY.doc